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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,796	01/04/2001	Krystyna Roslan-Szulc	PK1201T1	3261

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10/15/2004

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EXAMINER

WILSON, JOHN J

ART UNIT PAPER NUMBER

3732

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/754,796	Applicant(s) ROSLAN-SZULC, KRYSZYNA	
	Examiner John J. Wilson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims now include limitations to a "thermo-retractable foil" and an "electric reheater". The disclosure, as originally filed did not include these limitations, and therefore, they constitute improper new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 18 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 17, lines 14 and 15 appear to be out of place because they are followed by heating the instrument with the cover over a flame. In claim 18, line 14, "gutting" is unclear. Claim 27 is redundant with claim 25, for purposes of this Office Action, claim 27 is assumed to be dependent on claim 26, not claim 24.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisner et al (4728290) in view of Stearns (6095811) and Curry ((1742061). Eisner shows an elastic protective covering 10 made of a thermoshrinkable material, column 9, lines 15-25. The specific tolerance used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art looking to find the best match for the intended instrument. Further the tolerance that the sleeve may make with an inferentially claimed instrument is an obvious matter of choice in the use of the sleeve with an inferentially claimed element. Eisner does not show an elliptical shape. Stearns shows a non-round cross section, see Fig. 2. It would be obvious to one of ordinary skill in the art to modify Eisner to include a non-round shape as shown by Stearns in order to better fit the intended instrument. The specific shape used is an obvious matter of choice in shape to the skilled artisan looking to best match the shape of the intended instrument. Further, the shape before application is a pre step and is not given patentable weight. Eisner shows a tab, or wing, 18 located at the open end to assist in removing the cover, however, does not show hinged ends. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to

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modify the above combination to include two hinged ends as shown by Curry in order to make use of known ways of attaching wings to protective covers in the art.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Cooper et al ( ) and Curry (1742061). Fife shows a heat shrinkable protective covering 71, column 3, lines 49-51, having a wing, see the "proximal pull tab" in Fig. 10. Fife does not show an end in the shape of a semi-sphere. Cooper shows a rounded end, Fig. 2a. It would be obvious to one of ordinary skill in the art to modify Fife to include a rounded end as shown by Cooper in order to make use of well known shapes for protective covers. The above combination does not show two hinged wings. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to better cover the instrument. As to claim 3, Fife shows a flattened sheet in Fig. 4. The process of making is an obvious matter of choice in process steps to the skilled artisan. The specific shape of the cover is an obvious matter of choice in a non-critical shape of a known structure to one of ordinary skill in the art.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302). Fife shows employing a tubular protective covering 71 having a wing, see the "proximal pull tab" in Fig. 10, placing a dental instrument 112 into the cover and removing by pulling on the tab. To pull the tab in the direction of the body of the cover

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to remove would be an obvious matter of choice in the direction of pulling to one of ordinary skill in the art looking to remove a covering. The number of wings used is an obvious matter of choice in the number of a known element used to the skilled artisan.

Claims 7, 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) as applied to claim 6 above, and further in view of Eisner (4728290). Fife teaches that it is known to use a high speed drill, column 1, line 52, and suggest the use of a water tube, column 11, lines 15-17, however, does not show cutting a hole for a bur and a water pipe. Eisner teaches cutting a hole for the bur, column 9, lines 15-18. It would be obvious to one of ordinary skill in the art to modify the above combination to include cutting a hole as shown by Eisner in order to be able to use the instrument. Fife shows employing a tubular protective covering 71 having a wing, see the "proximal pull tab" in Fig. 10, placing a dental instrument 112 into the cover and removing by pulling on the tab. Fife teaches finishing the work and removing the cover, column 13, lines 14-18. Fife does not show rolling the cover when removing. Eisner teaches turning the cover inside out when removing by pulling on wing 18, column 9, lines 43-55. It would be obvious to one of ordinary skill in the art to modify Fife to include turning the cover inside out as shown by Eisner in order to protect the user from contamination. To roll the cover is an obvious matter of choice in the manner of turning the cover inside out to one of ordinary skill in the art. Fife does not show disinfecting and placing in a container. Eisner teaches disinfecting the cover after removal and placing it in a container, column 9, lines 53-60. Placing medical disposal

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material for burning is well known in the art and would be obvious to the skilled artisan in order to safely dispose of the material. Fife does not show sterilizing the instrument. Eisner teaches sterilizing the instrument, column 9, lines 28-29. It would be obvious to one of ordinary skill in the art to modify Fife to include sterilizing the instrument as shown by Eisner because the use of an instrument more than once is well known. As to claims 7 and 8, Fife teaches shrinking the cover 71, column 3, lines 49-51.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Eisner (4728290) as applied to claim 8 above and further in view of Holt et al (5070597), Watson (4142508) and Johnson (5098298). Fife teaches heating to shrink fit the cover, however, does not show using a flame. Holt teaches that it is known to heat by use of a flame, column 14, lines 30-33. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a flame to heat as shown by Holt in order to make use of known ways of heat shrinking covers. The above combination does not show using a screwing motion over the flame. Watson teaches that it is known to shrink a heat shrinkable material uniformly over its area by moving the flame with respect to the material while Johnson teaches rotating over a flame to evenly heat, column 4, lines 33-39. It would be obvious to one of ordinary skill in the art to modify the above combination to include relatively moving the material and flame as shown by Watson and further obvious to rotate the instrument over a flame as shown by Johnson in order to evenly heat, and therefore, evenly shrink the material. As to claim 11, the distance from the flame is an obvious

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matter of choice in the degree of a known parameter to the skilled artisan wishing to apply the desired heat.

Claims 9, 12-18 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife as applied to claim 6 above, and further in view of Holt et al (5070597), Watson (4142508), Johnson (5098298) and Eisner et al (4728290). Fife teaches heating the material, however, does not show using a flame. Holt teaches that it is known to heat by use of a flame, column 14, lines 30-33. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a flame to heat as shown by Holt in order to make use of known ways of heat shrinking covers. The above combination does not show using a screwing motion over the flame. Watson teaches that it is known to shrink a heat shrinkable material uniformly over its area by moving the flame with respect to the material while Johnson teaches rotating over a flame to evenly heat, column 4, lines 33-39. It would be obvious to one of ordinary skill in the art to modify the above combination to include relatively moving the material and flame as shown by Watson and further obvious to rotate the instrument over a flame as shown by Johnson in order to evenly heat, and therefore, evenly shrink the material. Fife suggest the use of a water tube, column 11, lines 15-17, however, does not show cutting a hole for a bur and a water pipe. Eisner teaches cutting a hole for the bur, column 9, lines 15-18. It would be obvious to one of ordinary skill in the art to modify the above combination to include cutting a hole as shown by Eisner in order to be able to use the instrument. As to claim 9, Fife does not show rolling the cover when



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removing. Eisner teaches turning the cover inside out when removing by pulling on wing 18, column 9, lines 43-55. It would be obvious to one of ordinary skill in the art to modify Fife to include turning the cover inside out as shown by Eisner in order to protect the user from contamination. To roll the cover is an obvious matter of choice in the manner of turning the cover inside out to one of ordinary skill in the art. As to claim 13, Fife teaches that it is known to use a high speed drill, column 1, line 52. As to claim 14, Eisner teaches wrapping as described above. The use of two wings in place of one is merely a matter of duplication of a known structure and use to one of ordinary skill in the art. As to claim 15, Fife does not show disinfecting and placing in a container. Eisner teaches disinfecting the cover after removal and placing it in a container, column 9, lines 53-60. Placing medical disposal material for burning is well known in the art and would be obvious to the skilled artisan in order to safely dispose of the material. Fife does not show sterilizing the instrument. As to claim 16, Fife does not show sterilizing the instrument. Eisner teaches sterilizing the instrument, column 9, lines 28-29. It would be obvious to one of ordinary skill in the art to modify Fife to include sterilizing the instrument as shown by Eisner because the use of an instrument more than once is well known. As to claims 21 and 23, the tolerance of the cover with respect to the instrument is an obvious matter of choice in the known parameters of how long the cover is heated to effect the degree of shrinking to the skilled artisan. As to claims 21-23, the type of heater used is an obvious matter of choice in known heaters to one of ordinary skill in the art.

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Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Cooper et al ( ) and Curry (1742061). Fife shows using a heat shrinkable protective covering 71, column 3, lines 49-51, having a wing, see the "proximal pull tab" in Fig. 10. Fife does not show using a cover having an end in the shape of a semi-sphere. Cooper shows a rounded end, Fig. 2a. It would be obvious to one of ordinary skill in the art to modify Fife to include a rounded end as shown by Cooper in order to make use of well known shapes for protective covers. The above combination does not show two hinged wings. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to better cover the instrument. As to claim 3, Fife shows a flattened sheet in Fig. 4. The process of making is an obvious matter of choice in process steps to the skilled artisan. The specific shape of the cover is an obvious matter of choice in a non-critical shape of a known structure to one of ordinary skill in the art.

Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Cooper et al ( ) and Curry (1742061) as applied to claim 24 above, and further in view of Holt et al (5070597), Watson (4142508), Johnson (5098298) and Eisner et al (4728290). Fife teaches heating the material, however, does not show using a flame. Holt teaches that it is known to heat by use of a flame, column 14, lines 30-33. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a flame to heat as shown by Holt in order to

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make use of known ways of heat shrinking covers. The above combination does not show using a screwing motion over the flame. Watson teaches that it is known to shrink a heat shrinkable material uniformly over its area by moving the flame with respect to the material while Johnson teaches rotating over a flame to evenly heat, column 4, lines 33-39. It would be obvious to one of ordinary skill in the art to modify the above combination to include relatively moving the material and flame as shown by Watson and further obvious to rotate the instrument over a flame as shown by Johnson in order to evenly heat, and therefore, evenly shrink the material. Fife suggest the use of a water tube, column 11, lines 15-17, however, does not show cutting a hole for a bur and a water pipe. Eisner teaches cutting a hole for the bur, column 9, lines 15-18. It would be obvious to one of ordinary skill in the art to modify the above combination to include cutting a hole as shown by Eisner in order to be able to use the instrument. Fife does not show rolling the cover when removing. Eisner teaches turning the cover inside out when removing by pulling on wing 18, column 9, lines 43-55. It would be obvious to one of ordinary skill in the art to modify Fife to include turning the cover inside out as shown by Eisner in order to protect the user from contamination. To roll the cover is an obvious matter of choice in the manner of turning the cover inside out to one of ordinary skill in the art. Fife teaches that it is known to use a high speed drill, column 1, line 52. The use of two wings in place of one is merely a matter of duplication of a known structure and use to one of ordinary skill in the art. Placing medical disposal material for burning is well known in the art and would be obvious to the skilled artisan in order to safely dispose of the material. Fife does not show sterilizing the instrument. Fife does

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not show sterilizing the instrument. Eisner teaches sterilizing the instrument, column 9, lines 28-29. It would be obvious to one of ordinary skill in the art to modify Fife to include sterilizing the instrument as shown by Eisner because the use of an instrument more than once is well known.

***Allowable Subject Matter***

The indication of allowable subject matter in claim 17 has been withdrawn in view of the newly cited references above.

***Remarks***

Applicant's remarks filed August 9, 2004 are held to be moot in view of the newly applied rejections and art above. The applied combination are held to result in an useful device and method.

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***Conclusion***

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in black ink, appearing to read "John J. Wilson", is positioned above the printed name and title.

**John J. Wilson  
Primary Examiner  
Art Unit 3732**

jjw

October 2, 2004

Fax (703) 872-9306

Work Schedule: Monday through Friday, Flex Time